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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/705,215	11/07/2003	Chuen-Ing Tseng	05408/100M235-US1	2925

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EXAMINER	
NWAONICHA, CHUKWUMA O	
ART UNIT	**PAPER NUMBER**
1621	

DATE MAILED: 06/02/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	10/705,215	TSENG ET AL.	
	Examiner	Art Unit	
	Chukwuma O. Nwaonicha	1621	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *11 April 2005*.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-16* is/are pending in the application.

4a) Of the above claim(s) *16* is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-15* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

DETAILED ACTION

Current Status

Claims 1-16 are pending in the application.

Priority

Applicants' claim for domestic priority under 35 U.S.C. 119(e) is acknowledged.

Election/Restrictions

Applicant's election with traverse of Group I (claims 1-15) in the reply filed on 4/11/05 is acknowledged. The traversal is on the ground(s) that claims 1-16 are related as a single invention.

The traversal is not found persuasive because the inventions of Group 1 is drawn to a process for making quaternary ammonium hydroxide while the invention of Group 2 is drawn to a process for making quaternary ammonium carbonate. Therefore, they are different inventions and require different search strategies that will impose an undue burden on the Examiner.

The requirement is still deemed proper and is therefore made **FINAL**.

Claim 16 is withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to a nonelected Groups, there being no allowable generic or linking claim. All claims consisting of Group 1: claims 1-15 will be examined on the merits. Applicants are reminded of their right to file divisional applications to the non-elected claims. Applicants' are reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in

the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

The factual inquiries set forth in *Graham* **v.** *John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

Claims 1-16 are rejected under 35 U.S.C. 103(a) as being unpatentable over Walker, {US 5,760,088}.

Applicants claim a process for making quaternary ammonium hydroxide with quaternary ammonium compound and metal hydroxide in an aminoalcohol solvent system.

Determination of the scope and content of the prior art (M.P.E.P. §2141.01)

Walker teaches a process for making quaternary ammonium hydroxide with quaternary ammonium compound and metal hydroxide in a solvent system; for example, single solvent system, mixture of solvent system, alcohol solvent system, alcohol/water solvent system or ammonia/water system. See column 2, lines 41-48, column 5, lines 13-24, column 6, lines 8-17 and column 7, example 1.

Ascertainment of the difference between the prior art and the claims (M.P.E.P.. §2141.02)

Walker process differs from the instant claims in that Walker does not specifically employ an aminoalcohol solvent system in the process for making quaternary ammonium hydroxide. However, Walker suggests the use of any solvent system including mixture of solvent system. See column 6, lines 8-17.

Finding of prima facie obviousness--rational and motivation (M.P.E.P.. §2142-2143)

The instantly claimed process would therefore have been suggested to one of ordinary skill because one of ordinary skill in the art would have a reasonable expectation of success in practicing the instant invention since Walker teaches the process to make quaternary ammonium hydroxide. Said person would have been motivated to practice the teaching of the reference cited because it demonstrates that quaternary ammonium compound with a metal hydroxide in a solvent system will produce quaternary ammonium hydroxide useful as a wood preservative. Therefore, use of aminoalcohol solvent system is not a patentable distinction because Walker teaches the elements of the claimed invention with sufficient guidance, particularity, and

with a reasonable expectation of success, that the invention would be *prima facie* obvious to one of ordinary skill in the art.

No claim is allowed.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Chukwuma O. Nwaonicha whose telephone number is 571-272-2908. The examiner can normally be reached on Monday thru Friday, 8:30am to 5:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Johann R. Richter can be reached on 571-272-0646. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Chukwuma O. Nwaonicha, Ph.D.
Patent Examiner
Art Unit: 1621
December 6, 2004.

J. PARSA
PRIMARY EXAMINER

Johann R. Richter, Ph.D., Esq.
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